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APPLICATION NO. 3718 FILING DATE 7/00

SPEC FIRST NAMED INVENTOR

ATTORNEY DOCKET NO.

SCH1653

MILLEN WHITE ZELANO & BRANIGAN  
ARLINGTON COURTHOUSE PLAZA I  
2200 CLARENDON BOULEVARD  
SUITE 1400  
ARLINGTON VA 22201

HM12/0430

EXAMINER

HARTLEY, M

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 04/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/446,328	SPECK ET AL.	
	<b>Examiner</b>	Art Unit	
	Michael G. Hartley	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 March 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 18/37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

The amendment filed 3/27/2001 has been entered. Claims 1-17 have been canceled. New claims 18-37 have been added.

***Response to Arguments***

Any previous rejections not reiterated herein have been obviated.

Applicant's arguments with respect to claims 18-37 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitecki (US 5,756,006) in view of Chang (Radiology), Ranney (US 5,260,050), Hilger (US 5,849,259), Brasch (US 6,009,342), Kirpoitin (US 5,411,730) and Platzek (US 6,054,117), for the reasons set forth in the office action mailed 9/27/2000.

Applicant's arguments filed 3/27/2001 have been fully considered but they are not persuasive.

Applicant asserts that the prior art, while teaching the methods of MRI and CT mammography using contrast agents, fails to teach methods of projection mammography (e.g., routine X-ray mammography) using contrast agents.

This is not found persuasive because Nitecki teaches iodine-containing contrast media which is useful for mammography in X-ray procedures and is administered intravenously, see column 2, lines 31-35. The X-ray mammography taught by Nitecki is not MR mammography (MRM) or CT mammography (CT/M) as suggested by applicant, rather is routine X-ray mammography (e.g., or projection mammography) as set forth in the instant claims. Thus, Nitecki discloses the use of contrast agents in

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methods of mammography as instantly claimed. The other cited prior art teaches that different contrast agents are known to be useful for various mammography modalities, while Nitecki teaches that similar contrast agents also show usefulness in regular (or projection) mammography. Although Nitecki does not teach all of the possible contrast agents encompassed by the instant claims, it would have been obvious to use essentially any contrast agent known in the art because the prior art teaches that various contrast agents may be used in an equivalent manner, in that, they have been used to obtain improved images for various imaging modalities of breast diagnosis, such as, mammography. One of ordinary skill in the art would have been motivated to employ other known contrast agents having desired properties, such as, reduced side effects, brighter images, etc., to optimize the methods disclosed by Nitecki.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. § 103(a).

Therefore, the rejection is adhered to.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

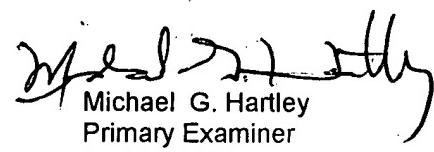
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (703) 308-4411.

The examiner can normally be reached on M-F, 7:30-5, off alternative mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be

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reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Michael G. Hartley  
Primary Examiner  
Art Unit 1619

MH  
April 24, 2001